

REMARKS

I. Introduction

Claims **1-43** are pending in the application. Claims **1, 6-7, 31, and 39** are independent. Claim **8** stands objected to, and all claims stand rejected. In particular:

(A) claims **39-43** stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent Application Publication No. 2002/0087413 (hereinafter “Mahaffy”);

(B) claims **7-8, 17, 19-22, and 25-29** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,324,520 (hereinafter “Walker”) in view of U.S. Patent Application Publication No. 2004/0249711 (hereinafter “Walker II”);

(C) claims **1-4, 6, and 9** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of “PTS: Vending Machine Refund System” (hereinafter “PTS”);

(D) claims **5 and 10** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS, in further view of U.S. Patent No. 7,286,901 (hereinafter “Whitten”);

(E) claims **11-15, 18, 23-24, and 30** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten;

(F) claim **16** stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten, in further view of PTS; and

(G) claims **31-38** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of U.S. Patent Application Publication No. 2002/0099662 (hereinafter “Joshi”).

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. The Examiner’s Objection

Claim **8** continues to stand object to for allegedly failing to further limit the claim upon which it depends. In response to Applicants’ previous arguments on this point, the

Examiner asserts:

that Claim 8 positively recites “receiving the input from the customer.” Claim 7 in which claim 8 depends from positively recites the same limitation by stating “receiving...from a customer, a request for a product to be dispensed from the vending machine” (i.e. an input).

Office Action, pg. 31, lines 1-5; emphasis added.

Applicants agree that claim 8 positively recites “receiving the input from the customer”. Applicants respectfully note, however, that the Examiner misinterprets the language of claim 7.

Claim 7 does indeed recite the receiving of “a request” from the customer (in the first limitation recited). Contrary to the Examiner’s assumption, however, this “request” is **not the same as** “the input” recited in claim 8. Instead, “the input” referenced by claim 8 specifically refers to the “input” recited in the second limitation recited in claim 7. Namely, the “input” from which it is determined that a customer service issue exists.

The Examiner’s current interpretation of the language of claim 7 is simply not reasonable in light of the specification as-filed, much less of the language recited within claim 7.

At least for these reasons, Applicants respectfully request that the objection to claim 8 be **withdrawn**.

III. The Examiner’s Rejections

A. 35 U.S.C. §102(b) – Mahaffy

Claims 39-43 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Mahaffy. Applicants traverse this ground for rejection as follows.

1. **The Examiner has failed to show how the reference teaches or suggests:** *receiving, by the vending machine and after at least one of the receiving of the indication of the request for the unit of product and the receiving of the indication of the payment for the requested unit of*

*product, an indication of a **malfunction of the vending machine** that has occurred with respect to the identified transaction*

Applicants respectfully assert that the Examiner has failed to show how Mahaffy teaches or suggests limitations of claims **39-43**. For example, the Examiner has failed to show how Mahaffy teaches or suggests *receiving, by the vending machine and after at least one of the receiving of the indication of the request for the unit of product and the receiving of the indication of the payment for the requested unit of product, an indication of a **malfunction of the vending machine** that has occurred with respect to the identified transaction.*

The Examiner appears to equate¹ the need for proof of identification described in Mahaffy to a “malfunction of the vending machine.” Office Action, pg. 4, lines 3-7.

Applicants respectfully disagree. Mahaffy describes a vending machine that can sell regular items as well as items that require proof of age/identification. The paragraph ([0032]) of Mahaffy cited by the Examiner as allegedly teaching the above-quoted limitation is descriptive of such a system. Specifically, the cited portion describes how the vending machine functions regularly and autonomously when regular products are sold and how the vending machine automatically contacts and involves a live operator for age-restricted products.

When proof of age/identification is required by the Mahaffy vending machine, there is **no malfunction**. The vending machine is **operating exactly as intended** and as described in the cited portion of Mahaffy.

Accordingly, at least because the Examiner has failed to show how Mahaffy teaches or suggests *receiving, by the vending machine and after at least one of the receiving of the indication of the request for the unit of product and the receiving of the indication of the payment for the requested unit of product, an indication of a **malfunction of the vending machine** that has occurred with respect to the identified transaction*, the Examiner has failed to establish a *prima facie* case that Mahaffy anticipates any of claims **39-43**.

¹ Applicants acknowledge that this is an assumption, since the actual language (“receiving an indication that a proof of again is required”) used by the Examiner is not entirely intelligible.

Applicants therefore respectfully request that this §102(b) ground for rejection of claims **39-43** be **withdrawn**.

B. 35 U.S.C. §103(a) – Walker, Walker II

Claims **7-8**, **17**, **19-22**, and **25-29** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Walker II. Applicants traverse this ground for rejection as follows.

Initially, Applicants respectfully note that Walker II may qualify as prior art under §102(e) because the filing date of Walker II of May 27, 2004 pre-dates the effective filing date of the present application, June 16, 2004. Walker II was not published until December 9, 2004, well after the effective filing date of the present application.

Applicants respectfully note and assert that the present application and Walker II were, at the time of invention of the subject matter of the present application, owned by Walker Digital, LLC. See, for example, Reel/Frame No. 015787/0038. Applicants also respectfully note and assert that, despite and/or in addition to any recorded assignment documents, the present application and Walker II were, at the time of invention of the subject matter of the present application, subject to a common obligation of assignment to Walker Digital, LLC.

Thus, since Walker II only qualifies as prior art under §102(e), Walker II is disqualified pursuant to §103(c) for purposes of §103(a) rejections. This current §103(a) ground for rejection is thus *moot*.

At least for this reason, Applicants respectfully request that this §103(a) ground for rejection of claims **7-8**, **17**, **19-22**, and **25-29** be **withdrawn**.

C. 35 U.S.C. §103(a) – Walker, PTS

Claims **1-4**, **6**, and **9** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims **1-4, 6, and 9** at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **1-4, 6, and 9**.

Applicants therefore respectfully request that these §103(a) rejections of claims **1-4, 6, and 9** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be

summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and PTS to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **1-4, 6, and 9** should therefore be **withdrawn**.

D. 35 U.S.C. §103(a) – Walker, PTS, Whitten

Claims **5** and **10** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS, in further view of Whitten. Claims **5** and **10** are believed patentable at least for depending upon patentable base claims (*i.e.*, claims **1** and **7**, respectively) and at least for the reasons described in relation thereto herein. Applicants further traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims **5** and **10** at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **5** and **10**.

Applicants therefore respectfully request that these §103(a) rejections of claims **5** and **10** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner’s unsupported conclusory statement that it would have been

obvious to combine and/or modify Walker and PTS and Whitten to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **5** and **10** should therefore be **withdrawn**.

E. 35 U.S.C. §103(a) – Walker, Whitten

Claims **11-15**, **18**, **23-24**, and **30** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten. Claims **11-15**, **18**, **23-24**, and **30** are believed patentable at least for depending upon patentable a base claim (*i.e.*, claim **7**) and at least for the reasons described in connection therewith herein. Applicants further traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims **11-15**, **18**, **23-24**, and **30** at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the

Examiner's opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **11-15, 18, 23-24, and 30**.

Applicants therefore respectfully request that these §103(a) rejections of claims **11-15, 18, 23-24, and 30** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and Whitten to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **11-15, 18, 23-24, and 30** should therefore be **withdrawn**.

F. 35 U.S.C. §103(a) – Walker, Whitten, PTS

Claim **16** stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten, in further view of PTS. Claim **16** is believed patentable at least for depending upon a patentable base claim (*i.e.*, claim **7**) and at least for the reasons described in connection therewith herein. Applicants further traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for claim **16** at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on claim **16**.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claim. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claim **16**.

Applicants therefore respectfully request that this §103(a) rejection of claim **16** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker, Whitten, and PTS to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claim **16** should therefore be **withdrawn**.

G. 35 U.S.C. §103(a) – Walker, Joshi

Claims **31-38** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Joshi. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to

combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims **31-38** at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **31-38**.

Applicants therefore respectfully request that these §103(a) rejections of claims **31-38** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and Joshi to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **31-38** should therefore be **withdrawn**.

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Office Action does not imply agreement therewith.

If there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-438-6867 or via e-mail at cfincham@finchamdowns.com, at the Examiner's convenience.

V. Petition for Extension of Time to Respond and Fees

Applicants hereby petition for a **one-month extension** of time and authorize the charge of **\$130.00** to Applicants' Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Applicants' Deposit Account No. 50-0271.

Furthermore, should any other extension of time be required or any other fee be due, please grant any extension of time which may be required to make this Amendment timely, and please charge any required fee to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

April 21, 2010
Date

/Carson C.K. Fincham, Reg.#54096/
Carson C.K. Fincham
Fincham Downs, LLC
Attorney for Applicants
Registration No. 54,096
cfincham@finchamdowns.com
(203) 438-6867 /voice
(203) 461-7300 /fax